REMARKS/ARGUMENTS

In the Office Action dated August 6, 2010 (hereinafter, "Office Action"), claims 1-4, 6-11, 13-21 and 23-28 were rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 8-11, 17 and 28 are being amended. Claims 29-30 are being added.

Applicant respectfully responds to the Office Action.

I.   Claims 1-3, 6, 8-11, 14-20, 23 and 25-28 Rejected Under 35 U.S.C. § 103(a)

Claims 1-3, 6, 8-11, 14-20, 23 and 25-28 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,466,329 to Mukai (hereinafter, "Mukai") in view of U.S. Patent No. 6,424,429 to Takahashi et al. (hereinafter, "Takahashi"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Independent claim 1 has been amended to recite that "the scanned image data is encapsulated initially according to properties determined by the scanner, and wherein properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs." Support for this claim subject matter is found in paragraphs [74]-[75] of the filed specification. As noted previously, Applicant's claim 1 enables a device to "treat a scan job as a copy job with an electronic output instead of paper." (Specification, paragraph [67].) For example, "[w]hen the user initiates a scan, the user is able to use the copy functions of the control panel of the

imaging device 120 to specify how the image data is to be document formatted." (Specification, paragraph [67].)

The combination of Mukai and Takahashi does not teach or suggest that "the scanned image data is encapsulated initially according to properties determined by the scanner, and wherein properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs," because the cited references do not indicate that there is a two step process in which the image data is encapsulated with the properties determined by the scanner and then modified according to the inputs received from a user. Specifically, with respect to Mukai, this reference teaches a system in which a scanned image may be obtained and "enclosed in PDL format" (Mukai, col. 9, lines 31-44) and that a scanned image may be "transfer[red] to the database server" (Mukai, col. 7, lines 19-22). As acknowledged by the Office Action, Mukai does not teach the use of copy functions with a scanning process. (Office Action, page 4). Thus, to the extent that Mukai indicates the use of a PDL format for a scan job, there is no indication that this PDL data for a scanned image is based upon inputs received from copy controls, as taught by claim 1. Moreover, there is no teaching or suggestion in Mukai that the scanned image is initially encapsulated with data based upon the settings of the scanner and then modified, in a second step, with different encapsulating data based upon the inputs received from the copy inputs. For example, there is no indication that the default scanner settings are being used to encapsulate a scan job with data and then these default settings are changed by having encapsulated data be added that is based upon the settings input by a user. Mukai indicates that control panel 500 may allow an operator to "input various settings and operation commands for copying, printing, facsimile, and document filing operations" and that such commands may include the "number of copies, the size of the copies, the degree of enlargement/reduction, duplex printing, and master-page printing, as well as setting of the recipient of a facsimile transmission or file transfer of a document." (Mukai, col. 9, lines 36-44). It is significant to note that "scanning" is not mentioned in this list of functions that may receive the delineated user inputs. Thus, there is no teaching in Mukai that a scan job may be "modified" by encapsulating it with data received from user inputs. For this reason, Mukai fails to teach or suggest

that "the scanned image data is encapsulated initially according to properties determined by the scanner, and wherein properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs," as required by amended claim 1.

With respect to Takahashi, this reference teaches a digital copier that can perform scanning and copying operations. (See Takahashi, col. 14, line 38 - col. 15, line 31.) To the extent that this reference teaches that copying functions may be adjusted (such as the margins of the paper), such an adjustment of properties occurs for a copy job and not for a scan job. There is no indication in this reference that inputs received from copy buttons are being applied to a scan job. Moreover, Takahashi indicates that, when performing a copy job, the "document is not copied under the default copying condition[s] (e.g., automatic paper selection, a size change ratio[] [of] 100%, and automatically adjusted density) obtained by just pressing the start key," but instead the user is allowed to enter values and change these default settings. (Takahashi, col. 14, lines 38-54.) Having the system recognize the user's commands for a particular print job does not relate to a scanning process. More specifically, having a user enter commands for a copy job does not indicate that there is a two-step process in the encapsulation process, namely that the scanned image data is encapsulated according to the properties of the scanner and then such properties are changed, as necessary, based upon user inputs received from the copy buttons. There is simply no indication that, during a scanning process in Takahashi, there is a two-step process that involves using inputs received from the copy commands. For this reason, Takahashi fails to teach or suggest that "the scanned image data is encapsulated initially according to properties determined by the scanner, and wherein properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs," as required by amended claim 1.

Further, the Office Action indicates:

> The Examiner understands that the Applicant is attempting to narrow the scope of the claims and recommends that the applicant further differentiate between a "scan" job and a "copy" job. It is suggested that the Applicant explicitly show how a "scan" job as claimed is different from performing a copy to file operation on a device, such as

those found in either Mukai or Castle (US 2005/0012956 A1 - briefly described below in the Conclusion).

Office Action, page 12. Applicant has amended claim 1 in an attempt to distinguish the process of claim 1 from a "copy to file operation" purportedly taught by Mukai or Castle. Specifically, as described above, Mukai's system involves scanning a document and then sending it to a server (see Mukai col. 7, lines 19-22), but does not indicate the two-step encapsulation process outlined in amended claim 1. Thus, to the extent that Mukai teaches a "copy to file" system, this "system" does not satisfy the subject matter of claim 1.

With respect to Castle, this reference indicates that a copier may scan a document and then send it to another document for storage or printing. (See Castle, Abstract.) Specifically, Castle teaches "scanning 126 a document to produce a digital image signal 22, converting 130 the digital image signal 22 to an output data stream 32, [and] directing 134 the output data stream 32 to the output path." (Castle, paragraph [0022].) As part of this process, the user may select "at least one output characteristic ... [such as] copy speed, output media size, output media weight, output media color, output media material (e.g., paper or transparency slide), color output (e.g., black-and-white or color), color resolution, optical resolution, printing resolution, or any other functional characteristic that affects output quality or copying speed." (Castle, paragraph [0023].) To the extent that Castle's system teaches sending a document or adjusting the settings of the document, there is no indication that the copy functions are being used with the scanning process. Moreover, there is no indication that Castle's process of scanning the document and then sending to another output device involves the two-step process described in claim 1, namely that the scanned image data is encapsulated according to the properties of the scanner and then such properties are changed, as necessary, based upon user inputs received from copy commands. There is no indication that there is an encapsulation of data in Castle's system based upon the scanner's default settings and that a second encapsulation occurs based upon the user's inputs received from the copy commands. There is no indication in Castle that the default settings of the scanner are first used or considered. Simply teaching scanning a document and sending it to another device is not the same as the two-step encapsulation process of

claim 1. Thus, the present claim 1, as amended, is distinct from a "copy job" or a "copy to file job" as described by the Office Action.

For at least the foregoing reasons, Applicant respectfully submits that amended claim 1 is allowable. Claims 2-3, 6, 8-10 and 28 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Amended claim 11 recites that "the scanned image data is encapsulated initially according to properties determined by the scanner, and wherein properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs." As discussed above, the combination of Mukai and Takahashi does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 11 is allowable. Claims 14-16 depend from claim 11, and are therefore allowable for at least the same reasons as claim 11.

Amended claim 17 recites that "the scanned image data is encapsulated initially according to properties determined by the scanner, and wherein properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs." As discussed above, the combination of Mukai and Takahashi does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 17 is allowable. Claims 18-20, 23 and 25-27 depend from claim 17, and are therefore allowable for at least the same reasons as claim 17.

II.   Claims 4 and 21 Rejected Under 35 U.S.C. § 103(a)

Claims 4 and 21 stand rejected under 35 U.S.C. § 103(a) based on Mukai in view of Takahashi and further in view of U.S. Patent Application Publication No. 2002/0114021 to Lavender et al. (hereinafter, "Lavender"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 4 depends from claim 1. Claim 21 depends from claim 17. As discussed above, Applicant respectfully submits that claims 1 and 17 are allowable. Accordingly, Applicant

respectfully submits that claims 4 and 21 are allowable for at least the same reasons as presented above in connection with claims 1 and 17, respectively.

III.   Claims 7, 13 and 24 Rejected Under 35 U.S.C. § 103(a)

Claims 7, 13 and 24 stand rejected under 35 U.S.C. § 103(a) based on Mukai in view of Takahashi and further in view of U.S. Patent No. 5,493,634 to Bonk et al. (hereinafter, "Bonk"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 7 depends from claim 1. Claim 13 depends from claim 11. Claim 24 depends from claim 17. As discussed above, Applicant respectfully submits that claims 1, 11 and 17 are allowable. Accordingly, Applicant respectfully submits that claims 7, 13 and 24 are allowable for at least the same reasons as presented above in connection with claims 1, 11 and 17, respectively.

IV.   New Claims 29-30

By this paper, new claims 29-30 have been added. Claim 29 recites that the scanned image data is in a "TIFF or JFIF file format." Support for this claim subject matter is found in paragraph [74] of the filed specification. Claim 30 recites that "the page description language further comprises duplex printing properties, number of copies and finishing properties that have no effect on the view of the document." Support for this claim subject matter is found in paragraph [77] of the filed specification. Applicant submits that such claim subject matter is not found in the cited references and respectfully requests allowance of these claims.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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